

21375YP

REMARKS

The Official Action of September 4, 2008, the references cited therein and the January 9, 2009 and February 24, 2009 Notice of Non-Compliant Amendment have been carefully considered. The amendments and remarks herein are considered to be responsive thereto. The claims remaining in the case are 1-3, 8-12, and 17. Pursuant to the Restriction Requirement Claims 4-7, 13-16, 18 have been canceled and 19-31 have been withdrawn without prejudice to refile. Claims 1 and 9-12 are amended to more precisely define the invention.

In the Notice of Non-Compliant Amendment of January 9, 2009, the Examiner states that claims 19-31 should be designated "Withdrawn" as they were withdrawn from consideration pursuant to the restriction requirement. By this amendment the claims have been withdrawn without prejudice to refile. In the notice of Non-Compliant Amendment of February 24, 2009, the Examiner states that claims 4-7, 13-16 and 18 should be referenced as "canceled" and not "withdrawn". The correction has been made.

The Oath and Declaration is objected to for failing to identify PCT/US04/112721 in accordance with 37 CFR 1.497(a)(2). However, 37 CFR 1.497(a)(2) requires the declaration to identify the specification to which it is attached. There is no requirement that the identifier be the same number given by the Office. Upon inspection of the upper right-hand corner of the Declarations sent by Applicants on October 18, 2005 and on February 26, 2007 one can see the Attorney Docket No. of 21375YP listed. In the top left-hand corner of the specification the same Attorney Docket No. is provided. Thus, the Declaration complies with 37 CFR 1.497(a)(2) in that Attorney Docket No. 21375YP appears in the upper right-hand corner of the document. Enclosed for your review is a copy of the October 18, 2005 Declaration.

Claims 1-3, 8-12, 17 have been amended to comply substantially with the restriction requirement of September 4, 2008. Specifically, "Het" in Claim 1 has been limited to thiazolyl and claims 4-7, and 13-16 have been canceled.

Claim 18 is rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement. To expedite a Notice of Allowance claim 18 has been herein deleted without prejudice to refile.

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Claims 1-3, 8-12, 17, are rejected under 35 USC 112, second paragraph, for failing to distinctly claim the invention. The Examiner states that in claim 1 an "or" should appear before the last substituent listed under the definition of "Het"; in R¹(o) after (p), in R²(d) after the definition (d), in R³(d) after the definition (e) and in R⁶, R⁷, and R⁸ after the definition of (d). By this amended claim 1 has been amended to insert "or" where appropriate. The Examiner further states that in claim 1 there is a valence problem wherever -C=C- appears. Claim 1 has been amended to replace -C=C- with -CH=CH-. No new matter has been added. It is well known in the art that -C=C- is the same as -CH=CH-. Thus, one of ordinary skill in the art would not deem -C=C- to have a valence problem. C

Claims 9-12 are further rejected under 35 USC 112, second paragraph because there is no "period" at the end of the claim and an "or" is needed at before the last compound listed. Claims 9-12 have been herein amended to add periods and an "or" where appropriate. Finally, claim 10 is rejected for lacking antecedent basis when R⁶ is "Cl". Claim 10 has been amended to be an independent claim thereby removing the need for an antecedent basis.

Claims 1-3, 8-12, 17 and 18 are rejected under 35 USC section 102 (b) as being anticipated by Oballa et al, Brooks et al., Pick et al., Tanaka et al., and Kimura et al. Specifically, the Examiner states that Oballa et al discloses compound 17, lines 29-30 and Pick et al disclose the compound in column 5. However, at least one of R⁶, R⁷, & R⁸ has to be other than hydrogen in the claimed invention unlike the Oballa et al., and Pick et al. The Brooks et al., compound differs from the claimed invention in that generic formula I does not provide for a biphenyl substituent. The Tanaka et al., and Kimura et al., compounds differ from the claimed invention in that in the claimed invention R⁴ and R⁵ is limited to hydrogen only. Thus, a more careful review of these references will reveal that they do not disclose the instantly claimed invention.

Claims 1-3, 8-12, 17 and 18 are rejected under 35 USC section 103(a) as being unpatentable over Oballa et al., Pick et al., and Tanaka et al. Applicants respectfully traverse. Oballa et al., is directed to compounds having cathepsin activity for bone disorder. Additionally, the generic formula I does not provide compounds with a

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thiazoly-biphenyl substituent. Pick et al., is directed to compounds for cardiac function and differs from the claimed invention in that R1 in the claimed invention cannot be C(O)NH₂ or CNOH₂. Finally, Tanaka et al is directed to compounds for Alzheimers disease which differ from the claimed invention in that R⁴ and R⁵ of the claimed invention cannot be OR, where R is hydrogen, alkyl, or alkenyl. There is no teaching or suggestion in any of these references of the claimed compounds for use in treating pain.

In light of the amendments and remarks herein Applicants believe the claims are in condition for allowance. The Examiner is respectfully requested to contact the undersigned at the number below if this would expedite the allowance.

Respectfully submitted,

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